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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,397	08/02/2001	Pierre Legrain	EGYPSA-013	6024

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EXAMINER	
MOSHER, MARY	
ART UNIT	PAPER NUMBER
1648	9

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/921,397	Legrain et al
Examiner	**Art Unit**
Mosher	1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *one* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-73* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-73* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

In making this restriction, it is assumed that claim 22 is actually drawn to polypeptides, and claim 24 is actually drawn to nucleic acids.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups 1-38. Claims 7-10, 22, 23, 25, 31-43 drawn to polypeptide of seq 1-38 or variant thereof, labeled polypeptide, polypeptide complex, classified in class 530, subclass 350.

39-76. Claims 1-6, 12-21, 24, 26, 62, drawn to nucleic acid encoding seq 1-38 or variant thereof, classified in class 536, subclass 23.72.

77-114. Claim 11, drawn to antibody directed against polypeptide of group 1-38, classified in class 530, subclass 387.9.

115-152. Claim 27-30, drawn to 2-hybrid method using nucleic acid of group 39-76, classified in class 435, subclass 6.

153-190. Claim 44-50, nucleic acid encoding a compound made of a protein of group 1-38, a covalently bound ligand, and a specific binding partner to the first ligand, classified in class 536, subclass 23.1.

191-228. Claims 51, 53, 54-61 method of detecting a polypeptide of interest by binding to immobilized protein, classified in class 436, subclass 501.

229-266. Claims 52, 53, method of detecting a polypeptide of interest by binding to nucleic acid(?), classified in class 435, subclass 6.

267-304 Claims 63, 64, treatment method using polypeptide, classified in class 514, subclass 12.

305. Claim 65-71, method of selecting a polypeptide by selecting a collection of nucleic acid which bind to a polypeptide (??), sequencing the nucleic acids, selecting nucleic acids which encode a binding polypeptide and have some common fragment, and aligning multiple sequences, classified in class 702, subclass 19.

306. Claim 72, nucleic acid of unspecified structure, classified in class 536, subclass 23.1.

307. Claim 73, polypeptide of unspecified structure, classified in class 530, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in MPEP §806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because products 1-38, 39-76, and 77-114 constitute apparently distinct inventions for the following reasons: the polypeptides of groups 1-38, the polynucleotides of groups 39-76, and the antibodies of groups 77-114 are chemically distinct products, separately classified having separate fields of search. The function and existence of either DNA or protein is not dependent on the existence of the other. The products of each group can be independently synthesized by

chemical means. An antibody is encoded by an entirely different DNA than that of the protein which is bound by that antibody, and the primary sequence of the antibody bears no relationship to the sequence of the detected protein. Each of the products 1-114 have distinct structures and separate uses and are not disclosed as being capable of use together. Further, it would place undue burden on the examiner to examine several independent inventions in one application.

Inventions 39-76 are related to inventions 115-172 and 229-266 as product and alternative processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids, as claimed, can be used to produce the isolated proteins encoded by the sequence, or in either the 2-hybrid assay of inventions 115-172 or the nucleic acid/protein binding assay of inventions 229-266.

Inventions 39-76 and 153-190 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination for patentability because patentability could lie in encoding a combination of three distinct molecules (a polypeptide, a ligand which covalently binds the polypeptide, and a second ligand which binds

to the first ligand) in a single nucleic acid sequence. The subcombination has separate utility such as utility in making the isolated polypeptides.

Inventions 1-38 are related to inventions 191-228 and 267-304 as product and alternative processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides as claimed can be used alternatively in the detection method of groups 191-228, or the therapeutic method of groups 267-304.

Inventions 305-307 are unrelated to each other and to all of the other groups. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the bioinformatic method of invention 305 can be used to identify nucleic acids and proteins, such as those claimed in other groups, but the identification process is not a process of making a product, and the process used to identify a product does not confer any identifiable characteristics upon the product which is identified. Since identical products can be discovered by other methods, the products are distinct and unrelated to a process which could be used to identify them.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent search requirements, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

November 7, 2002

MARY E. MOSHER
PRIMARY EXAMINER
GROUP ~~1800~~ 1600